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| GRAHAM, CLEMENT B | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/666,631

Applicant(s)

BIRCH ET AL.

Examiner

Clement B. Graham

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/7/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20, are rejected under 35 U.S.C. 102(e) as being anticipated by Lai (U.S Pub: 2005/0044197).

As per claim 1, Lai discloses a computerized method for billing for web services comprising the steps of:

creating a descriptor file designating a pre-defined element, storing said descriptor file in a tangible computer readable medium (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986) configuring a handler resident on a computer comprising a processor operable to execute computer readable instructions to monitor a web service network communication, between a service requestor and a service provider, for said predefined element in said descriptor file, configuring said handler to send said pre-defined element to a set of programmed instructions to create an event record(see para 0063, 0411, 0465, 0640, 0968, 0976, 0986) wherein the set of programmed instructions is configured to copy the pre-defined element from the network communication into the event record, electronically transmitting said event record to a billing system for further processing, wherein the handler configured to monitor for said predefined element in said descriptor file is located at an entity taken from the list of entities consisting of: a) the service requestor and b) the service provider (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

Art Unit: 3691

As per claim 2, Lai discloses wherein said programmed instructions are configured to determine whether an event corresponding to said event record requires authorization (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 3, Lai discloses a computerized method as claimed in claim 1 wherein said programmed instructions are configured to determine whether an event corresponding to said event record requires rating (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 4, Lai discloses further comprising the steps of transforming said pre-defined element according to a set of instructions in said descriptor file before transmitting said event record to the billing system (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 5, Lai discloses wherein said web service network communication comprises a request for a web service and a response to said request wherein said request comprises a start time and said response comprises an end time and further comprising the steps of: creating a first event record comprising said start time and queuing said first event record in said billing system (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986) creating a second event record comprising said end time matching said first event record with said second event record (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986) calculating a charge for said web service based on said start time and said end time, returning said charge to said service provider sending said first event record to said billing system, and sending said second event record to said billing system, queuing said first event record in said billing system (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 6, Lai discloses wherein said billing system comprises programmed billing instructions coded to determine whether a web service transaction may be performed (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 7, Lai discloses wherein said programmed billing instructions are configured to determine if said service requestor is permitted to access said web service transaction (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

Art Unit: 3691

As per claim 8, Lai discloses wherein said billing system returns a response to said web service provider indicating whether said web service transaction should proceed (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 9, Lai discloses wherein said programmed billing instructions are configured to determine whether said service requestor is solvent enough to purchase said web service transaction (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 10, Lai discloses wherein said programmed billing instructions are configured to return a response to a set of application code associated with said web service provider indicating whether said web service transaction should proceed (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 11, Lai discloses wherein said programmed billing instructions are configured to return a response to said web service provider indicating a quantity for said web service transaction to proceed (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 12, Lai discloses wherein said web service network communication comprises a SOAP message stream; wherein the service requestor accesses the service provider on a direct peer-to-peer basis; and wherein the handler is located at the service provider (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 13, Lai discloses wherein said SOAP message stream comprises a set of data including quality of service information, authorization key fields, version numbers, encrypted account information, and start/stop time (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 14, Lai discloses wherein said billing system uses said pre-defined element in said SOAP message stream to support at least one pre-defined billing plan (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 15, Lai discloses wherein said pre-defined billing plans is chosen from a list consisting of subscriptions, bundled plans, time-based usage plans, re-occurring charges, one-time charges, discount plans based on usage, discount plans based on time-of-day, discount plans based on customer loyalty, discount plans based on family/organization relationships, tiered plans, location dependent pricing, and combinations thereof (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

Art Unit: 3691

As per claim 16, Lai discloses a tangible computer readable medium having computer executable instructions for performing a method comprising:
receiving a descriptor file designating at least one pre-defined element and utilizing said descriptor file to monitor a web service network communication for said pre-defined element(s)
copying said-predefined element(s) from said network communication into a record
electronically sending said record to a billing system for further processing (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 17, Lai discloses a system for billing for web services comprising:
a descriptor file, a handler a record wherein said descriptor file designates at least one pre-defined elements said handler is configured to monitor a web service network communication, between a service requestor and a service provider(see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28) and to intercept said communication if said communication corresponds to said at least one pre- defined element in said descriptor file said handler is further configured to copy said pre-defined elements from said network communication into a record a billing system and said handler is further configured to electronically transmit said record to a billing system for further processing (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 18, Lai discloses wherein said billing system is embedded within a web service server; wherein said further processing comprises determining whether said service requestor is solvent enough to purchase a web service corresponding to said web service network communication; and wherein said web service network communication comprises a SOAP message stream; wherein said handler is located at the service provider; and wherein the service requestor accesses the service provider on a direct peer-to-peer basis (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

As per claim 19, Lai discloses wherein the monitored web service network communication is between a service requestor and a service provider, and wherein the computer readable medium is located at the service provider (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

Art Unit: 3691

As per claim 20, Lai discloses wherein the web service network communication comprises a communication where the service requestor accesses the service provider on a direct peer-to-peer basis (see para 0063, 0411, 0465, 0640, 0968, 0976, 0986, and claim 8, 28).

Conclusion

RESPONSE TO ARGUMENTS

3. Applicant's arguments filed 6/7/10 has been fully considered but they are moot in view of new grounds of rejection.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art
Unit 3691

CG

August 14, 2010